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Paper No. 11  
RFC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

In re U.S. Tsubaki, Inc.

Serial No. 75/684,041

James C. Wray for U.S. Tsubaki, Inc.

M. Catherine Faint, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Walters and Drost, Administrative Trademark  
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 15, 1999, applicant filed the above-referenced application to register the mark "E-SPROCKET" on the Principal Register for "electronic catalog and ordering systems for the ordering, purchasing, shipping and tracking of industrial chain drive and idler sprockets," in Class 9. The basis for filing the application was applicant's assertion that it possessed a bona fide intent to use the mark in commerce in connection with these goods.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the mark applicant seeks to register is merely descriptive of the goods set forth in the application. She explained that the letter "E" would be understood as an indication that applicant's catalog and ordering systems are electronic, that sprockets are the products which applicant's catalog and ordering systems offer, and therefore that the combination, "E-SPROCKET," is merely descriptive of characteristics of features of the goods, so the mark is not registrable under Section 2(e)(1) of the Act.

Applicant responded to the refusal to register by amending the identification-of-goods clause to read as follows: "electronic catalog and ordering systems comprising computers, computer software, CD-ROMs and computer disks for ordering, purchasing, shipping and tracking roller chain, sprockets, engineering class chain, and power transmission units and components, in International Class 9." Applicant argued that the refusal to register was not well taken because neither its catalogs nor the products listed therein would be referred to as an "E-SPROCKET." Applicant characterized the mark it seeks to register as "an unusual combination of characters," and argued that a combination of descriptive elements as a

composite mark may result in a mark which is not merely descriptive.

The amendment to the identification-of-goods clause was accepted, but the Examining Attorney was not persuaded by applicant's arguments on the issue of descriptiveness. The second Office Action made the refusal to register final. Submitted with that action in support of the refusal was a dictionary definition of a "sprocket" as "any of various toothlike projections arranged on a wheel rim to engage the links of a chain." The Examining Attorney also made of record an excerpt from an article published in the USA TODAY newspaper on July 8, 1998, retrieved from the Nexis automated database, which explains that "when you see a technological term that starts with the letter 'e' and a hyphen, it most likely is an e-commerce-driven term. And nine times out of ten, the 'e' means electronic." An entry from a computer glossary was also submitted. It shows that the letter "e" followed by a hyphen, means "electronic." The computer glossary goes on to explain that this prefix "may be attached to anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc." As additional support for the refusal to register, the Examining Attorney submitted an entry from an on-line

acronym list which shows that the letter "E" is used as an acronym for "electronic."

Applicant responded by arguing that sprockets have not "moved from paper," nor can they be made of paper, so that "in the present case, a new and different commercial impression is created by the unusual combination of these two words, which impart such a bizarre and incongruous meaning that it cannot be characterized as primarily merely descriptive." Submitted with applicant's response were copies of catalog sheets showing metal chains and sprockets.

When the final refusal to register was maintained, applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed appeal briefs, but applicant did not request an oral hearing before the Board.

The sole issue presented by this appeal is whether the mark "E-SPROCKET" would be understood to be merely descriptive of the goods with which applicant intends to use it, namely, an electronic catalog and ordering systems for ordering, purchasing, shipping and tracking goods which include sprockets. Based on careful consideration of the

record in this application<sup>1</sup>, the arguments presented by applicant and the Examining Attorney, and the relevant legal precedent on this issue, we hold that the refusal to register is proper.

The test for determining whether a mark is merely descriptive within the meaning of Section 2(e)(1) of the Lanham Act is well settled. A mark is unregistrable under this section of the Act if it immediately and forthwith conveys information with regard to a characteristic, function, feature, purpose or use of the relevant goods. In *re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In *re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); In *re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). The mark must be considered in relation to the goods specified in the application, rather than in the abstract. In *re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is sufficient if the term in question describes a single significant attribute or characteristic of the goods. In *re MBAssociates*, 180 USPQ 338 (TTAB 1973).

When these principles are considered in relation to the instant application, it is clear that if the mark were

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<sup>1</sup> The Examining Attorney's objection to applicant's reference in its appeal brief to the results of an Internet search conducted by counsel for applicant is sustained. The record on appeal closed with the filing of the Notice of Appeal. Trademark Rule 2.142(d). No evidence of such a search was timely submitted.

used in connection with the goods set forth in the application, as amended, it would immediately be understood to convey significant information about such electronic catalogs and ordering systems, namely that such catalogs were in electronic or digital form, rather than printed on paper, and that sprockets are available through such catalogs and ordering systems.

Applicant's arguments that its goods are not "electronic sprockets" and that its sprockets have not "moved from paper" to an "electronic alternative" demonstrate a lack of understanding of what the issue in this appeal is. The goods set forth in the application are electronic catalogs and ordering systems, not sprockets. Catalogs have traditionally been printed listings of products which could be purchased, but catalogs are today also available electronically. This application makes it clear that applicant intends to offer its catalog in electronic form. No one considering the mark in connection with the goods specified in the application would understand the mark to be a reference to "electronic sprockets," or that the sprockets available through applicant's electronic catalogs and ordering systems are made of paper.

Furthermore, this combination of terms which are individually descriptive of applicant's goods is no less descriptive than its component parts. The combination does not result in an incongruous, arbitrary, or even only suggestive term. Applicant's argument to this effect is without either logical or evidentiary support.

The decision of the Board in *In re Styleclick.com, Inc.*, 57 USPQ2d 1445 (TTAB 2000), is directly on point. There we held the mark "E FASHION" to be merely descriptive of software for consumer use in shopping via global computer networks, and software for providing fashion, beauty and shopping advice. We stated that the letter "e," when used as a prefix in the manner of applicant's mark, had the generally recognized meaning of "electronic" in terms of computers and the Internet, and that when this non-source-identifying prefix is combined with descriptive terminology, the resulting combination is merely descriptive itself.

The same reasoning applies in the instant case. The mark applicant seeks to register combines the descriptive prefix "E" with the descriptive term "SPROCKET," which is the generic name for the goods featured in applicant's catalogs. The combined term, "E-SPROCKET," is merely descriptive of applicant's electronic catalogs and ordering

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systems for sprockets. The term sought to be registered immediately conveys the facts that applicant's catalogs are electronic and that they feature sprockets.

DECISION: The refusal to register under Section 2(e)(1) of the Lanham Act is affirmed.



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